

A Response to the Office Action:

A. Status of the Claims

Claims 33, 35-36, 38-39, 41, and 44-46, 48-52, and 54-69 are pending. Claims 35, 36, 54, 56, 58, 60 and 65-66 have been amended.

B. The Indefiniteness Rejection Is Overcome

The Action rejects claims 35, 54, 56, 58, 60 and 65-66 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Amended claims 35, 54, 56, 58, 60 and 65-66 require a “transparent polymeric sheet” or a “transparent cover sheet”. Claim 36 has been amended to change “the second surface” to “a back surface of the base sheet.” Accordingly the rejections are overcome and the present claims are definite and satisfy all of the requirements under 35 U.S.C. § 112, second paragraph.

C. The Obviousness Rejections Are Overcome

1. Claims 33, 35-36, 38, 41, 44-46, and 48-51 Are Not Obvious Over U.S. Patent 2,006,744 to Pierce in View of U.S. Patent No. 6,007,104 to Draper and U.S. Patent 5,709,746 to Ballard

Claims 33, 35-36, 38, 41, 44-46, and 48-51 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent 2,006,744 to Pierce in view of U.S. Patent No. 6,007,104 to Draper and U.S. Patent 5,709,746 to Ballard.

The Action acknowledges that “Pierce does not specifically teach using a backing sheet to protect the adhesive from foreign matter or a bar code for identification and recording of the fingerprint.” According to the Action:

Further, utilizing a backing sheet for the Pierce structure would protect the adhesive and allow for the use of permanent adhesive which when contacted the base could not be tampered with. The releasable sheet,

taught by Ballard would be readily removed to expose the adhesive on the Pierce finger print structure and subsequently allow the security of the samples collected.

Action, page 5.

The Action therefore proposes the following reasons to modify the Pierce device to include a backing sheet: (1) to protect the adhesive; and (2) to allow for the use of permanent adhesive to prevent tampering after the cover sheet contacts the base sheet. Upon examination, neither of the reasons proposed would have prompted a person of ordinary skill in the art to add a backing sheet to Pierce.

a. Permanent Adhesive Would Render Pierce Device Inoperable for Intended Purpose

The use of a permanent adhesive would render the Pierce device completely inoperable for its intended purpose of lifting fingerprints from surfaces. If the Pierce adhesive were permanent, it would permanently stick to the surface from which a print was being lifted. This would not allow the user to lift a copy of the print from the surface to use for forensic analysis. Pierce explicitly teaches away from the use of a permanent adhesive. For example, Pierce states:

This adhesive will stick to the original surface to which it is applied such as sheet member 1 to such an extent that it may be applied and removed from adhesive engagement with other surfaces without becoming separated from member 1. It may, and is generally, called a pressure sensitive adhesive. This adhesive has the further advantage, that it can be removed and re-applied to any surface.

Pierce, column 2, lines 15-23.

Because the Pierce device contains a pressure-sensitive adhesive that can be “removed and re-applied” to any surface, the adhesive can not be a permanent adhesive. “If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP §2143.01 *citing In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also Tec Air, Inc. v. Denso*

Mfg. Michigan Inc., 192 F.3d 1353 (Fed. Cir. 1999) (“[i]f when combined the references “would produce a seemingly inoperative device,” then they teach away from the combination”) (citation omitted). Because utilizing a permanent adhesive in the Pierce device would render it inoperable for its intended purpose, there is no motivation to make such a modification.

b. Backing Sheet Not Needed to Protect Adhesive

With respect to protecting the adhesive, there is again no motivation to modify the Pierce device by adding a backing sheet. For example, Pierce states:

To preserve this quality in the adhesive it is usually kept applied to some surface to prevent it from collecting foreign matter. For this and other purposes in connection with this invention the sheet member 1 has the adhesive coated surface 2 thereof applied to a protecting transparent sheet member 3.

Pierce, column 2, lines 23-29.

As clearly explained above, Pierce protects the adhesive with transparent sheet member 3. Therefore, there is no need to add a backing sheet to Pierce in order to protect the adhesive.

Because the Pierce device can not be used with a permanent adhesive, and the existing adhesive is already protected, the addition of a backing sheet serves no useful purpose and would add to the cost and complexity of the design. Such a modification would not have been desirable, and therefore would not have been obvious. *See In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (“Stated another way, the prior art as a whole must ‘suggest the desirability’ of the combination) (internal quotation omitted); *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000) (“Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.”); *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (“The mere fact that

the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”)

Adding cost and complexity to the Pierce device without providing an additional benefit is not desirable. Therefore, it is not obvious to modify the Pierce device by adding a backing sheet.

c. Summary

For at least the reasons detailed above, it would not have been obvious to modify the Pierce device to include a backing sheet releasably secured to a transparent polymeric sheet. Therefore, independent claim 33 is not unpatentable over Pierce in view of Draper and Ballard and the rejection should be withdrawn.

Dependent claims 35, 36, 38, 41, 44-46, and 48-51 depend from claim 33 and are therefore also patentable for at least the reasons explained above. Furthermore, the dependent claims contain additional limitations that render them patentable over the cited references. For example, claim 51 requires the storage structure to comprise a biological sample that is a bodily fluid. It would not have been obvious to one skilled in the art to modify the Pierce device to comprise a bodily fluid. Such a modification would render the device unsatisfactory for its intended purpose, *i.e.* to lift fingerprints or other images from a surface for forensic analysis. Because the modification would render the device unsatisfactory for its intended purpose, the modification would not have been obvious. *See* MPEP §2143.01.

2. Claims 33, 36, 38-39, 41, 44-46, 48-52 and 54-69 Are Not Obvious Over U.S. Patent No. 6,162,485 to Chang in View of and U.S. Patent 6,007,104 to Draper

a. Chang and Draper Do Not Teach or Suggest All Limitations

Claims 33, 36, 38-39, 41, 44-46, 48-52 and 54-69 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,162,485 to Chang in View of and U.S. Patent 6,007,104 to Draper.

Independent claims 33 and 55 require a “transparent polymeric sheet comprising an adhesive that contacts the biological sample and a front surface of the base sheet to enclose the biological sample between the transparent polymeric sheet and the front surface of the base sheet.” In contrast, Chang does not teach such an arrangement. For example, in the discussion of Chang, the Action states that “[t]he release liner is adhered to the substrate (16) of the security document on the non-release side of the release liner (26) by means of a permanent laminating or non-pressure sensitive adhesive (30)[.]” Action, page 6 (citing column 9, lines 22-26 of Chang). An annotated copy of Figure 3B is shown below.

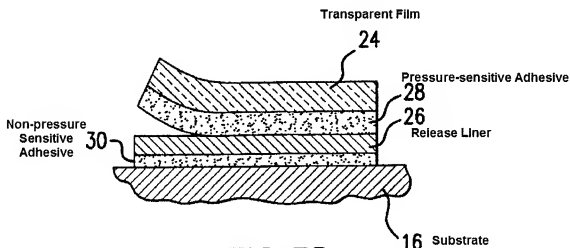


FIG.3B

As shown and described above, the Chang device comprises a transparent film 24 with a pressure-sensitive adhesive 28 that contacts the release liner 26. Chang does not teach a transparent polymeric sheet comprising an adhesive that contacts a biological sample and a front surface of a base sheet, as required by claim 33. The Chang device appears to be configured so that transparent film 24 and pressure-sensitive adhesive 28 can be peeled back from release liner 26 so that a biological sample can be placed between the adhesive and release liner. However, the Chang device is not configured so that pressure-sensitive adhesive 28 can contact a front surface (or any surface) of substrate 16. As previously described, release liner 26 is adhered to substrate 16 with a permanent laminate or non-pressure sensitive adhesive. Therefore, release liner 26 will be between pressure-sensitive adhesive 28 and substrate 16, and pressure-sensitive adhesive 28 will not contact substrate 16. Consequently, Chang does not teach a “transparent polymeric sheet comprising an adhesive that contacts the biological sample and a front surface of the base sheet to enclose the biological sample between the transparent polymeric sheet and the front surface of the base sheet.”

Chang also does not suggest such an arrangement, and in fact teaches that “pressure sensitive adhesive 28 can be easily peeled from release liner 26 for later application is [sic] to the latent image on area 14, when desired.” Column 9, lines 28-31. Therefore, Chang teaches away from allowing pressure sensitive adhesive 28 to contact the base sheet rather than the release liner.

The Action cites Draper for teaching a form of identification material printed on the substrate. The Action does not cite Draper as teaching or suggesting a transparent polymeric sheet comprising an adhesive that contacts a biological sample and a front surface of the base sheet to enclose the biological sample. A review of Draper also indicates that the reference

provides no such teaching or suggestion. Draper does not teach a transparent polymeric sheet, much less one that comprises an adhesive that contacts a biological sample and a front surface of a base sheet to enclose a biological sample.

b. Summary

In summary, neither Chang nor Draper teach or suggest a “transparent polymeric sheet comprising an adhesive that contacts the biological sample and a front surface of the base sheet to enclose the biological sample between the transparent polymeric sheet and the front surface of the base sheet.” For at least the reasons provided above, the references do not teach or suggest all of the limitations of independent either claim 33 or claim 55 and a prima facie case of obviousness has not been established. MPEP §2143. Dependent claims 36, 38-39, 41, 44-46, 48-52, 54, and 56-69 depend from claims 33 or 55 and are also allowable for at least these reasons.

F. Conclusion

Applicants believe that the present document is a full and complete response to the December 28, 2006 Office Action. The present case is in condition for allowance, and such favorable action is requested.

Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-3072.

Respectfully submitted,



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